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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,418	07/27/2006	Jochen Moench	3775	7301
7590 Striker Striker & Stenby 103 East Neck Road Huntington, NY 11743		04/23/2009	EXAMINER MACARTHUR, VICTOR L.	
			ART UNIT 3679	PAPER NUMBER PAPER
		MAIL DATE 04/23/2009	DELIVERY MODE	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/587,418	<b>Applicant(s)</b> MOENCH ET AL.
	<b>Examiner</b> VICTOR MACARTHUR	<b>Art Unit</b> 3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

#### Status

- 1) Responsive to communication(s) filed on 09 March 2009.  
 2a) This action is FINAL.      2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 14-25 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 14-22,24 and 25 is/are rejected.  
 7) Claim(s) 23 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 27 July 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Drawings*

The drawings were received on 11/17/2008. These drawings are **NOT** acceptable since they contain new matter. Specifically, the dimensions for element 15 as newly added to figure 2 (i.e., having a top to bottom length approximately 12 times that of the left to right width) does not have antecedent basis in the original disclosure. Note that the drawings filed 11/17/2008 would have also been objected to as follows (if they did not include new matter):

- Alterations, overwriting, interlineations, not accepted. See 37 CFR 1.84(c).
- Margins not properly sized as 2.5cm (top), 2.5cm (left), 1.5cm (right), 1.0cm (bottom). See 37 CFR 1.84(g).
- Separate views of figure 2 not labeled separately or properly. See 37 CFR 1.84(h).
- The lines, numbers & letters not uniformly thick and well defined, clean, durable, and black (poor line quality). See 37 CFR 1.84(l).
- The drawings are objected to under 37 CFR 1.84(h)(5) because Figure 2 show(s) modified forms of construction in the same view.

The drawings filed 7/27/2006 remain objected to as follows:

- The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following limitations must be shown or canceled from the claims:

- “wherein said width dimension in said predetermined direction (Y) is smaller than said axial dimension and said radial dimension (Z)” (claim 1) must be shown or the feature(s) canceled from the claim(s). Note that currently, figures 1 and 2 show separate embodiments viewed from a common position that does not reveal the width in the direction (Y). Since it appears that this limitation cannot be shown without the addition of new matter (see above) this limitation must be removed from the claims and/or pursued in a Continuation in Part application that includes drawings fully showing the limitation. No new matter may be entered in this application.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Corrected drawing sheets in compliance with 37 CFR 1.84 and 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be

necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Claim Objections***

Claims 14-25 are objected to because of the following informalities:

- Each element or step of the claims has not been separated by a line indentation.  
See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- The claim 17 limitation "connect said motor housing to said transmission housing" was previously set forth in claim 14.

Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 14-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Farmer US

2004/0178028.

The prior art discloses (fig.7) applicant's claimed "assembly" structure to include a transmission and transmission housing (312), motor, shaft and motor housing (300) connection device (320) including at least one connecting element (left 320, right 320).

As detailed above, the prior art structure is substantially identical to the claimed structure such that the PTO must presume claimed functions/properties to be inherent, thus presenting a *prima facie* case and properly shifting the burden to prove otherwise with evidence to the applicant. It is fairly the applicant's burden to obtain and test the prior art since the Patent Office is unable to manufacture or obtain prior art products. Mere allegation that the prior art does not inherently possess applicant's claimed functions/properties is not sufficient without actual evidence proving as much. See the following:

MPEP §2112.01 (I);

*In re Ludtke*, 441 F.2d 660, 664, 169 USPQ 563, 566 (CCPA 1971);

*In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972);

*In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977);

*In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986);

*In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed.Cir. 1990);

*In re Schreiber*, 128 F.3d 1473, 1478 44 USPQ2d 1429, 1432 (Fed.Cir.1997)

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farmer US 2004/0178028.

Farmer does not expressly state that the connecting element is plastic or coated with viscoelastic material. However:

- The examiner takes **OFFICIAL NOTICE** that it is extremely well known in the art that plastic is desirable for lowering weight and cost; and that viscoelastic coatings are desirable for resisting corrosion.
- It has generally been recognized that selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).
- Furthermore, the applicant has failed to demonstrate criticality by any showing of unexpected result derived from visco elastic coated plastic over any other material. Wherein a specific limitation has no criticality, case law can be relied upon as the sole rationale in an obviousness rejection. See MPEP 2144.04. “[T]he results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See U.S. Const., Art. I, section 8, cl.8.” In re KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007).
- Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to choose a visco elastic coated plastic for the connecting element for the purpose of saving weight, lowering cost and resisting corrosion; and

further since the limitation has no criticality and has thus been established by the case law cited above to be an obvious design consideration within the skill of the art.

*Allowable Subject Matter*

Claim 23 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. However, since the limitation "said width... being smaller than said axial dimension... and than said radial dimension" (claim 14) cannot be shown in the drawings without addition of new matter (see objection to the drawings above; the examiner suggests the following amendment to put the claims in condition for allowance:

- Cancel claims 15-25

- Replace text of claim 14 with the following:

--An assembly comprising:

a transmission having a transmission housing,

a motor having a motor housing and a motor shaft for transmitting a torque from said motor to said transmission, said shaft defining a central axis of rotation,

at least two identical U-shaped connecting elements of elastic plastic material, said elements arranged in a radially symmetrical manner about said axis,

each connecting element having: a first leg perpendicular to said axis, an end face of the first leg receiving said motor housing, a second leg perpendicular to said axis, an end face of the second leg receiving said transmission housing, a bridge piece extending parallel to said axis, the

bridge piece connecting the first leg to the second leg, and a substantially ellipsoidal concave recess facing towards said axis, and

wherein said connecting elements elastically separate said motor housing from said transmission housing along said axis and substantially decouple vibrations of said motor from said transmission.--

***Response to Arguments***

Applicant's arguments with regard to the claim rejections have been fully considered but they are not persuasive.

Regarding the drawings received on 11/17/2008, applicant has failed to point out where the originally filed application provides antecedent basis for dimensions for element 15 as newly for figure 2 therein (i.e., having a top to bottom length approximately 12 times that of the left to right width). Note that the recitation that the dimension in the Y direction is small in comparison to the dimensions in the X direction and the Z direction does not provide antecedent basis for any specific magnitude, let alone a top to bottom length 12 times that of the left to right width. For that matter, no recitation of a rectangular cross sectional shape at all is set forth in the original disclosure. The 11/17/2008 drawings will not be entered.

The arguments regarding the objections of the drawings filed 7/27/2006 are not persuasive at face value. Applicant's mere denial does not constitute a persuasive argument.

The remaining arguments are moot in view of the new grounds of rejection.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

April 22, 2009

/Victor MacArthur/  
Primary Examiner, Art Unit 3679